

## **REMARKS**

The application included claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, and 36-38 prior to entering this amendment.

Claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, 36, and 37 are indicated as containing allowable subject matter.

The Applicant amends claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-32, 36, and 37, and cancels claim 38 without prejudice.

The Applicant adds new claim 39. No new matter is added.

The application remains with claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, 36, 37, and 39 after entering this amendment.

### **Summary of Telephonic Examiner Interview**

Applicant's attorney spoke with Examiner Callahan on October 29, 2010 and November 4, 2010 to discuss the present grounds of rejection. Examiner Callahan acknowledged that previously presented claims 11, 12, 14-20, 34, and 36 were not rejected on any basis in the Office Action dated August 31, 2010. Applicant's attorney further discussed the amendment of claims 1 and 31, and agreement was reached that the present amendment would overcome the 35 U.S.C. § 101 grounds for rejection.

### **APPLICANT'S COMMENTS ON EXAMINER'S STATEMENT OF ALLOWABLE SUBJECT MATTER**

Applicant acknowledges the Examiner's statement of allowable subject matter of claims 1, 2, 4-6, 8-12, 14-20, 22, 24-28, 30-34, 36, and 37 and agrees that the claimed subject matter is patentable. However, Applicant takes no position regarding the statement of allowable subject matter presented by the Examiner other than the positions Applicant may have previously taken during prosecution. Therefore, the Examiner's statement of allowable subject matter should not be attributed to Applicant as an indication of the basis for Applicant's belief that the claims are patentable. Furthermore, Applicant respectfully asserts that there may also be additional reasons for patentability of the claimed subject matter not explicitly stated in this record and Applicant does not waive any rights to such arguments by not further addressing such reasons herein.

### Claim Rejections - 35 U.S.C. § 101

The Examiner rejected claims 1, 2, 4-6, 8-10, 22, 24-28, 30-33, and 37 under 35 U.S.C. § 101.

Without admitting the propriety of the rejection, Applicant amends claim 1, 2, 4-6, 8-10, 22, 24-28, 30-32, 36, and 37 only to expedite prosecution, and without prejudice to pursuing the claims as previously presented or in other forms in a continuation or other application. For example, claim 1 is amended to recite, in part, a method comprising: *identifying, with a processing device, computer files comprising software code*. The recitation of the processing device is believed to tie the method claim to a particular machine that make the claim statutory under 35 U.S.C. § 101.

In rejecting claims 22, 24-28, 30-32, and 37, the Examiner alleged that “the claims to not positively recite any limitation that specifies the software as being embodied in a *non-transitory* computer readable medium (page 3, final paragraph of the August 31, 2010 Office Action). Whereas Applicant appreciates that the USPTO proposes reciting “non-transitory” computer readable medium, Applicant respectfully submits that the proposed language is not required by 35 U.S.C. § 101, nor is it the sole means by which to claim statutory matter comprising computer readable medium.

*Nuijten* holds that claims solely reciting “physical but transitory forms of signal transmission such as radio broadcasts, electrical signals through a wire, and light pulses through a fiber-optic cable” are not directed to statutory subject matter. *In re Nuijten*, 500 F.3d 1346, 1353-1357 (Fed. Cir. 2007). That is, only “*Nuijten’s* signals, ***standing alone***, are not ‘manufactures’ under the meaning of that term in § 101.” *Nuijten* at 1357 (emphasis added). Notably, none of the claims at issue in *Nuijten* were CRM claims. To the contrary, the Court in *Nuijten* explicitly points out that the inventor was allowed a claim directed to “‘a ***storage medium having stored thereon a signal*** with embedded supplemental data,’ where the ***stored signal*** has essentially the encoding properties described above.” *Nuijten* at 1351 (emphasis added). Accordingly, there is no proper basis for the Office Action’s blanket allegation that CRM claims lacking the limitation “non-transitory” are per-se non-statutory subject matter.

Further, Applicant notes that the Board of Patent Appeals and Interferences (BPAI) has declined, absent evidence to the contrary, to broadly interpret the phrase “computer readable medium” to include propagating signals. See, e.g., *Ex Parte Azuma*, Appeal No. 2009-003902,

(B.P.A.I., September 14, 2009); *Ex parte Gutta*, 93 USPQ2d 1025, 1034 (B.P.A.I., August 10, 2009, *precedential*); *Ex parte Daughtrey*, Appeal No. 2008-000202 (B.P.A.I., July 31, 2009). For example in *Daughtrey*, the BPAI held

[I]t does not appear that “computer readable medium” had any commonly-recognized understanding in the art at the time of Appellant’s invention. As such, we decline to adopt a definition of the phrase “computer readable medium” that broadly includes signals, when the Appellant has clearly stated on the record that he did not intend the phrase to include signals.

Applicant respectfully submits that, in view of the foregoing, a person skilled in the art would not have taken the ordinary and customary meaning of the phrase “computer-readable medium having instructions stored thereon” to include embodiments where the medium is solely a propagating transitory signal of the type found to be non-statutory subject matter in *Nuijten*. Accordingly, there is no proper basis for the rejection under 35 U.S.C. §101. Nevertheless, and only to expedite prosecution, Applicant amends claims 22, 24-28, 30-32, and 37 to recite “non-transitory” computer readable medium.

As claims 2, 4-6, 8-10, 22, 24-28, 30, 32, 33, and 37 depend directly or indirectly from independent claims 1 or 31, the comments and revisions directed above to claims 1 or 31 apply equally to claims 2, 4-6, 8-10, 22, 24-28, 30, 32, 33, and 37, respectively. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 2, 4-6, 8-10, 22, 24-28, 30-33, and 37 is respectfully requested.

### **Claim Rejections - 35 U.S.C. § 103**

The Examiner rejected claim 38 under 35 U.S.C. § 103(a) over Cowie *et al.* (U.S. Patent Application Publication No. 2003/0023865), Atkinson (U.S. Patent 5,892,904), and Pierre Richer: SANS/GIAC Practical Assignment for GSEC Certification Version 1.4b: Steganalysis: Detecting hidden information with computer forensic analysis, SANS Institute 2003.

Without admitting the propriety of the rejection, Applicant cancels claim 38 only to expedite prosecution, and without prejudice to pursuing the claim as previously presented or in other forms in a continuation or other application. Accordingly, the rejection of claim 38 is believed to be moot.

### **Claim Amendments – General Comments**

Claims 11, 12, 14-20, 34, and 36 are amended for grammatical purposes or to further clarify the claim language only to expedite prosecution, and without prejudice to pursuing the claims as previously presented or in other forms in a continuation or other application. The claim amendments are not being made to overcome any of the cited references, and Applicant neither intends nor believes that these amendments operate to narrow the scope of the claims.

Any statements made by the Examiner that are not addressed by the Applicant do not necessarily constitute agreement by the Applicant. In some cases, the Applicant may have amended or argued the independent claims thereby obviating grounds for rejection of the dependent claims.


### **CONCLUSION**

For the foregoing reasons, the Applicant respectfully requests reconsideration and allowance of the present application. The Examiner is encouraged to telephone the undersigned at (503) 546-1812 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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A handwritten signature in cursive script, reading "Bryan Kirkpatrick", written in dark ink.

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